

REMARKS

Status of the Application

Claims 1-20 were pending in the application at the time the Office Action was mailed.

Claims 1, 2, 4-12, and 14-20 were rejected, and claims 3 and 13 were objected to. No claims were allowed.

Upon entry of this amendment, claims 3-5, 10, and 12 will have been cancelled, claims 1, 11, and 18 will have been amended, and no new claims will have been added. Therefore, claims 1, 2, 6-9, 11, and 13-20 will be before the examiner for consideration.

Allowable Subject Matter

The Office Action stated that claims 3 and 13 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Although the applicant neither agrees nor acquiesces in the rejections set forth in the Office Action, for the sole purpose of expediting prosecution of the application, claim 1 has herewith been amended to include the limitations of claim 3. Claim 13 is believed to be allowable in its original form for the reasons presented below.

Claim Objections

Claims 12 and 18 were objected to for informalities. As claim 12 has been canceled and claim 18 has been amended to depend from claim 11, withdrawal of these objections is respectfully requested.

Double Patenting

Claim 1 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,452,791 in view of Toizono et al. (JP 06289969), and Claim 3 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,452,791 in view of Toizono et al., (JP 06289969). Accompanying this reply is a terminal disclaimer signed by the applicant and the required fee. Withdrawal of the rejection is therefore requested.

35 USC §103- Raasch (US 6,262,716) in view of Tominaga (JP 09204246)

Claims 1-2, 6 and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Raasch (US 6,262,716) in view of Tominaga (JP 09204246). Claim 1, from which claims 2, 6, and 8 depend, has herewith been amended to include the limitations of canceled claim 3. As the examiner indicated that claim 3 would be allowable if rewritten in independent form, withdrawal of this rejection is respectfully requested.

35 USC §103- Toizono et al. (JP 06289969) in view of Tominaga (JP 09204246)

Claims 1, 4-5, 11-12, 14-16 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Toizono et al. (JP 06289969) in view of Tominaga (JP 09204246).

The rejection with respect to claims 1, 4, 5, and 12 is now moot as claim 1 has been amended to include the limitations of now canceled claim 3, and claims 4, 5, and 12 have been canceled.

In rejecting claim 11 and those claims depending from claim 11, the Office Action reasoned “[i]t would have been obvious to combine the teaching of Tominaga with the notebook computer disclosed by Toizono et al. for the advantage of only providing wrist supports in the

two areas where the users wrists will be thus reducing the amount of wrist support material needed and therefore reducing costs.” MPEP 2143.01, citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), however, points out that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. The advantage of reducing costs asserted by the Office Action is not suggested by the cited references.

Moreover, MPEP 2143.01, citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), further indicates that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Combining the fore arm pads of Tominaga with the notebook computer of Toizono et al., however, would not result in the notebook computer of claim 12 because the height of Tominaga’s fore arm pads (see Fig. 2 and the machine translation) is too great to be practical for use with Toizono et al.’s notebook. For example, in a notebook computer having Tominaga’s fore arm pads positioned on the computer’s top panel, an operator’s fingers would likely be positioned too far away from the keyboard to comfortably depress the keys. Moreover, the height of Tominaga’s fore arm pads would also prevent a notebook computer from being placed in a closed configuration (Claim 11 has been amended to indicate that “the wrist supports are sufficiently compressible so that the notebook computer can be placed in the closed position with the wrist supports attached to the top panel”).

For the foregoing reasons, the Office Action has not made out a *prima facie* case of obviousness. Accordingly, withdrawal of the rejection is respectfully requested.

35 USC §103- Raasch (US 6,262,716) in view of Tominaga (JP 09204246) further in view of Smith et al. (US 5,628,483)

Claims 7 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Raasch (US 6,262,716) in view of Tominaga (JP 09204246) as applied to claims 1-2, 6 and 8 above, and further in view of Smith et al. (US 5,628,483). Claim 1, from which claims 7 and 9 depend, has herewith been amended to include the limitations of canceled claim 3. As the examiner indicated that claim 3 would be allowable if rewritten in independent form, withdrawal of this rejection is respectfully requested.

35 USC §103- Toizono et al. (JP 06289969) in view of Tominaga (JP 09204246) further in view of Smith et al. (US 5,628,483)

Claims 10, 17 and 19-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Toizono et al. (JP 06289969) in view of Tominaga (JP 09204246), as applied to claims 1, 4-5, 11-12, 14-16 and 18 above and further in view of Smith et al. In particular, the Office Action stated “[w]ith respect to claims 10, 17 and 19-20, Toizono et al. in view of Tominaga discloses the claimed notebook computer except for the synthetic sponge. However, Smith et al. teaches that it is known to use sponge has a wrist support.”

Claim 10 has herewith been canceled. Claims 17 and 19-20 depend from claim 11. For the reasons described above, because Toizono et al. in view of Tominaga are not properly combinable for the purposes of 35 USC 103, the combination of Toizono et al., Tominaga, and Smith is also not proper for the purposes of 35 USC 103. Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion:

The currently pending claims are supported by the specification and are patentable over the prior art. No new matter has been added. Allowance of the application is respectfully requested.

This amendment is accompanied by a retroactive petition for a one month extension of time, a terminal disclaimer, and the required fees.

The examiner is cordially invited to call the undersigned if clarification is needed on any matter within this amendment, or if the examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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